

Remarks

Reconsideration of this Application is respectfully requested.

Upon entry of the foregoing amendment, claims 1-22 are pending in the application, with claims 1, 6, 7, and 9-22 being the independent claims. Claims 5, 14, and 21 are sought to be amended to correct clerical errors (i.e., misspelling of the word process, a phrase inadvertently omitted, and a missing period at the end of a claim sentence). These changes are believed to introduce no new matter, and their entry is respectfully requested.

Based on the following remarks, Applicants respectfully request that the Examiner reconsider all outstanding concerns and that they be withdrawn.

Telephonic Interview

Applicants and Applicants' representative wish to thank Examiner Krisna Lim for the telephonic interview with the Applicants' representative, Mr. Timothy A. Doyle, on December 28, 2007.

During the interview, Applicants' representative and the Examiner discussed the concerns under 37 C.F.R. §§ 1.4 and 1.121 to the Amendment filed May 29, 2007. Regarding the concern under 37 C.F.R. § 1.4, the Examiner stated that it was a mistake to include a reference to this rule in the Office Action and agreed that there was nothing of concern with the signature of the Amendment filed May 29, 2007.

Regarding the concerns under 37 C.F.R. § 1.121, Applicants' representative stated that he would include, in the present Amendment and Reply Under 37 C.F.R. § 1.111, a statement

directing the Examiner to an embodiment described in the specification of the present patent application that teaches the features of amended claims to demonstrate that no new matter was introduced by the amendments. Applicants' representative also stated that he would include a statement that the newly added claims are neither anticipated by nor unpatentable over the applied documents.

Regarding the Examiner's concern that there is no explanation or statement whether the newly added claims are the same or different from the old claims, the Examiner explained that this concern was from the viewpoint as to whether the newly added claims are directed to an invention that is independent and distinct from the invention to which the old claims are directed. Applicants' representative stated that he would include a statement in the present Amendment and Reply Under 37 C.F.R. § 1.111 that addresses this issue.

Specification Support for Amended Claims

In the Office Action dated Sept. 25, 2007, the Examiner requested that Applicants address the concern that there is no “teaching of the newly amended claims in the specification including drawings to make sure that the specificalton (*sic*) fully discloses the claimed invention.” *Office Action at 2.* Applicants respectfully disagree.

In the Office Action Reply dated May 29, 2007, the newly amended claims contained two types of textual amendments. In the first type of textual amendment, the phrase “not created by a user” was replaced by “created by an unauthorized process.” *See amended claims 1, 6, 7, 9-13 in the Office Action Reply dated May 29, 2007.* This amended claim

language finds support in the specification, as the specification contains numerous references to "unauthorized" messages and/or e-mails. *See U.S. Pat. Appl. Publ. 2004/0103162 at paras. 12, 13, 16, 18, 26, and 28.* Moreover, the specification underscores that "computer viruses can compose and send e-mail without a user being aware of the transmission of such 'unauthorized' e-mail." *See U.S. Pat. Appl. Publ. 2004/0103162 at para. 12.* The use of the words "compose" and "send" establish that computer viruses are processes, and further establishes that such processes are "unauthorized" since the e-mail they produce is "unauthorized e-mail".

In the second type of textual amendment of the claim language, the phrase "an agent" was replaced by "the unauthorized process". *See amended claims 2, 3, and 5 in the Office Action Reply dated May 29, 2007.* As noted above, there are numerous references in the specification to "unauthorized" messages and/or e-mails, as well as the reference to computer viruses that are *processes* by virtue of their ability to "compose" and "send" such "unauthorized" e-mail.

Finally, claims 14-22, which were newly added in the Office Action Reply dated May 29, 2007, as well as claim 3, which was amended in the Office Action Reply dated May 29, 2007, contain the following text: "one of a virus, a trojan horse and an agent other than an owner of a mail client source of the message". Such claim language also finds support in the specification. As noted above, the specification contains numerous references to "unauthorized" messages and/or e-mails. *See U.S. Pat. Appl. Publ. 2004/0103162 at paras. 12, 13, 16, 18, 26, and 28.* Moreover, the specification underscores that "computer viruses can compose and send e-mail without a user being aware of the transmission of such

'unauthorized' e-mail." *See U.S. Pat. Appl. Publ. 2004/0103162 at para. 12.* Accordingly, "virus" has express support in the specification, and "an agent other than an owner of a mail client source of the message" has implicit support since actions by "an agent other than an owner" are "unauthorized". Moreover, "a trojan horse" also has implicit support since a "trojan horse" is understood by those of ordinary skill in the art to be:

"Software that appears to do something normal but which contains a trap door or attack program. A Trojan Horse program can be used to break into a network through a World Wide Web site. A Trojan Horse is dangerous software." *Harry Newton, Newton's Telecom Dictionary, p. 619, 11th ed., Flatiron Publishing, Inc., 1996.*

Therefore, the text "one of a virus, a trojan horse and an agent other than an owner of a mail client source of the message" finds support in the specification.

Accordingly, claims 1-3, 5-7, and 9-13, which were amended in the Office Action Reply dated May 29, 2007, together with claims 14-22, which were newly added in the Office Action Reply dated May 29, 2007, contain subject matter that is supported by the specification, as required by 35 U.S.C. § 112 ¶ 1. Therefore, it is requested that the Examiner withdraw the concern of lack of written description support.

New Claims Are Not Independent or Distinct From Old Claims

Examiner has noted that "there is no explanation [*sic*] or statement whether or not the newly added claims are the same or different from the old claims." *Office Action at 2.* Examiner notes that the "old" claims (i.e., claims 1-13) are directed to the e-mail that is created by authorized process while the "newly added" claims (i.e., claims 14-22) are directed

to the e-mail that is recognized by one of a virus, a Trojan horse and an agent. *Id.* Applicants believe that Examiner's use of the word "authorized" when describing the old claims is in error, and that Examiner meant "unauthorized" when describing the old claims. The subsequent discussion is based on this premise.

As noted in the telephonic interview, the Examiner contends that claims 1-22 are directed to two "distinct" and "independent" inventions. They are as follows:

Group I, claims 1-13, the "old" claims "directed to [an] email that is created by [an] [un]authorized process". *Office Action at 2, with presumed error corrected as noted above.*

Group II, claims 14-22, the "new" claims "directed to [an] email that is recognized by one of a virus, a trojan horse and an agent." *Office Action at 2.*

Applicants respectfully submit that the Group I claims and Group II claims are not independent. "Inventions as claimed are independent if there is no disclosed relationship between the inventions, that is, they are unconnected in design, operation, and effect." *M.P.E.P. § 806.06.* However, Applicants submit that the Group I claims and the Group II claims are connected in design, operation, and effect. Both groups of claims are directed to a system that alerts or warns a user of a pending e-mail transmission, such that e-mail addresses can be corrected or the e-mail transmission cancelled and thereby prevent unintended or unauthorized e-mail transmissions. Therefore, both groups of claims are connected in design (e.g., addition of a modify/cancel control), operation (display of dialog box to user), and effect (permits modification and/or cancellation of e-mail transmission). Accordingly, the Group I claims and the Group II claims are not independent.

Moreover, Applicants respectfully submit that the Group I claims and Group II claims are not distinct. The burden is on the Examiner to provide a *prima facie* case by way of an example that the claims do not overlap in scope, are not obvious variants, and are either not capable of use together or can have a materially different design, mode of operation, function, or effect. *M.P.E.P.* § 806.05(j). Since no example has been provided in the Office Action to which a response can be made, Applicants submit that this concern should be withdrawn.

Finally, even assuming, *arguendo*, that the two groups of claims are independent or distinct, Applicants respectfully submit that the Group I claims and the Group II claims should be examined together, since they are directed to similar, overlapping subject matter. “If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.” *M.P.E.P.* § 803. Both Group I claims and Group II claims have similar features recited, which should encompass a similar search. For example, both groups deal with a process or apparatus that deals with suspending e-mail transmissions to enable a user to avoid inadvertent e-mail transmissions or to terminate unauthorized e-mails generated by viruses, etc. For at least this reason, a search of these two groups as claimed does not impose a serious burden upon the Examiner. Accordingly, reconsideration and withdrawal of the Examiner’s contention that the two groups of claims are independent or distinct is thereby respectfully requested.

Claims Are Not Anticipated by Examiner's References

In earlier Office Actions dated August 11, 2004 and March 25, 2005, claims 1-13 had been rejected under 35 U.S.C. § 102 as allegedly being anticipated by U.S. Pat. No. 6,073,133 issued to Chrabaszcz ("Chrabaszcz"). However, Chrabaszcz does not teach each and every feature of claims 1-13, nor each and every feature of the added claims 14-22.

Chrabaszcz describes a method and system for sending e-mail messages that have been created by the user. *See, e.g.*, Chrabaszcz, abstract. Chrabaszcz is particularly directed to making sure that attachments intended to be sent are actually affixed. *See, e.g.*, Chrabaszcz, abstract. At no point in Chrabaszcz does it disclose e-mails that are created by an unauthorized process, or by a virus, trojan horse, or an agent other than an owner of a mail client source of the message. By contrast, independent claims 1, 6, 7, 9-13 recite e-mails "created by an unauthorized process". Similarly, independent claims 14-22 recite e-mails "by one of a virus, trojan horse, and an agent other than an owner of a mail client source of the message". Thus, Chrabaszcz does not teach or suggest at least these recited features of claims 1, 6, 7, 9-22.

For at least these reasons, independent claims 1, 6, 7, 9-22 are not anticipated by Chrabaszcz. Dependent claims 2-5 and 8 are patentable for at least the same reasons as independent claims 1 and 7, from which they directly or indirectly depend, and further in view of their own respective features.

Claims Are Not Rendered Obvious by Examiner's References

In earlier Office Actions dated August 11, 2004 and March 25, 2005, claims 1-13 had been rejected under 35 U.S.C. § 103 as allegedly being unpatentable over Chrabaszc in view of U.S. Pat. No. 6,434,601 issued to Rollins ("Rollins"). Even assuming, *arguendo*, that these two references, Chrabaszc and Rollins, may be combined in the manner indicated by the Examiner (which the Applicants do not concede), the combination does not teach each and every feature of claims 1-13, nor each and every feature of the added claims 14-22.

Both Chrabaszc and Rollins describe a method and system for sending e-mail messages that have been created by the user. *See, e.g.*, Chrabaszc, abstract; Rollins, Ref. Desig. S10 in FIG. 1, Col. 3, Lns. 47-48. Chrabaszc is particularly directed to making sure that attachments intended to be sent are actually affixed. *See, e.g.*, Chrabaszc, abstract. Rollins is particularly directed to a system that includes messages that are not complete, such as missing an address. *See, e.g.*, Rollins, Ref. Desig. S30 in FIG.1, Col. 4, Lns. 44-53. At no point in Chrabaszc and Rollins do they disclose e-mails that are created by an unauthorized process, or by one of a virus, trojan horse, and an agent other than an owner of a mail client source of the message. By contrast, independent claims 1, 6, 7, 9-13 recite e-mails "created by an unauthorized process". Similarly, independent claims 14-22 recite e-mails "by one of a virus, trojan horse, and an agent other than an owner of a mail client source of the message ". Thus, the combination of Chrabaszc and Rollins do not teach or suggest at least these recited features of claims 1, 6, 7, 9-22.

For at least these reasons, independent claims 1, 6, 7, 9-22 are patentable over the combination of Chrabaszcz and Rollins. Dependent claims 2-5 and 8 are patentable for at least the same reasons as independent claims 1 and 7, from which they directly or indirectly depend, and further in view of their own respective features.

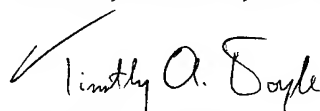
Conclusion

All of the stated grounds of concerns have been accommodated or properly traversed. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding concerns and that they be withdrawn. Applicants believe that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Amendment and Reply is respectfully requested.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.

A handwritten signature in black ink, appearing to read "Timothy A. Doyle". The signature is written in a cursive, flowing style.

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